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10/622,911	07/18/2003	Joseph Leo Messina JR.		2822
7590 09/14/2004				
Thomas A. O'Rourke Bodner & O'Rourke Ste 108 425 Broadhollow Road Melville, NY 11747		EXAMINER EDWARDS, LAURA ESTELLE		
		ART UNIT PAPER NUMBER		
		1734		

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/622,911

Applicant(s)

MESSINA, JOSEPH LEO

Examiner

Laura E. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 082604.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a painting apparatus, classified in class 118, subclass 323.
- II. Claims 13-16, drawn to a brush, classified in class 15, subclass 196.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are deemed independent and distinct inventions because the invention of Group I is to a painting apparatus using a brush of different structure than the brush of Group II. Also, the brush of Group II can be used for in a different environment other than painting such as a cosmetic applicator for applying blush powder to the skin.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. O'Rourke on 9/2/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Specification***

The abstract of the disclosure is objected to because it contains legal phraseology such as "means" and said language should be removed (see lines 4-5). Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

Claims 3-5 and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3-5, Applicant recites limitations to the substrate and how the substrate is intended to be used with the apparatus of claim 1 such that it is unclear how these claims recite structural limitations. These claims appear to recite process limitations.

With respect to claims 3 and 5, Applicant recites a base in relation to the substrate but it is unclear whether the base is a part of the claimed invention because the base is defined in relation to the substrate (intended to be used with the apparatus) and not in structural relation to the apparatus including the hanging applicator member.

In claim 12, it is unclear how the random pattern applied on the substrate in response to air further structurally limits the apparatus of claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Woods (US 4,928,625).

Woods teaches an apparatus for creating an image comprising a first support member (14) having a hanging applicator member (20 or 54) movably connected thereto, said hanging applicator being provided with at least one reservoir of material (i.e., paint) to be applied to a substrate (50), said reservoir having a delivery means extending therefrom for transporting said material to a brush means (28), said brush means capable of providing a random pattern of material to said substrate in response to pressure from flowing air.

With respect to claim 9, the first support member (14) has an upper horizontally extending arm member having horizontally disposed screws (34) supported by a vertically extended rod (32).

With respect to claim 12, while this claim has been considered, it has been given no patentable weight. However, the freely suspended apparatus inherently would be capable of creating different patterns on the substrate in the presence of a source of flowing air.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woods (US 4,928,625) in view of Bolton et al (US 4,247,339).

The teachings of Woods have been mentioned above but Woods is silent concerning brush means comprising a hollow tubular member having a first end and second end, the first end receiving material from the delivery means and the second end having bristles. However, Woods does recognize that the applicator member can have a fluid supply thereon and that the applicator can take any form as evidenced by col. 3, lines 54+ and col. 4, lines 17-29 and Bolton et al teach a self contained painting applicator means in the form of a hollow tubular member having a first end and second end, the first end receiving material from the delivery means and the second end having bristles (see Figs. 1, 2, 4, and 5). It would have been obvious to one of ordinary skill in the art to provide the applicator means as taught by Bolton et al in the Woods apparatus as an obvious modification of a paint applying means. The use of the bristles of the paint applying means would provide for a random pattern of brushed strokes on the surface of the substrate.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woods (US 4,928,625) in view of Steward (US 4,199,868).

The teachings of Woods have been mentioned above but Woods is silent concerning the substrate being supported on a base having a concave shape. However, it was known in the art at the time the invention was made, to provide a concave shaped based for receipt of a substrate having a freely suspended hanging applicator means applied a random pattern to the substrate as evidenced by Steward (See col. 2, lines 37-42). It would have been obvious to one of ordinary skill in the art to provide the concave base as taught by Steward with the Woods apparatus as an alternative surface for supporting the substrate.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woods (US 4,928,625).

The teachings of Woods have been mentioned above. Woods is silent concerning the application material being an ink or pastel, however, it is within the purview of one of ordinary skill in the art to utilize any form of painting fluid (i.e., pastel, ink, pigment, dye) in the Woods apparatus as all such forms of painting fluid have been used to decorate a substrate including a t-shirt.

#### *Allowable Subject Matter*

Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10 and 11 are allowable because there is no teaching or suggestion in the prior art of an apparatus for creating an image comprising the combination of a first support member having a hanging applicator member movably connected thereto, said hanging applicator being provided with at least one reservoir of material to be applied to a substrate, said reservoir having a delivery means extending therefrom for transporting said material to a brush means, said brush means providing a random pattern of material to said substrate in response to pressure from flowing air wherein the first support member is a horizontal member being supported by at least one vertical member and there is an anchor leg having a first end and second end, the first end to rest on a support surface and the second end having an opening for receiving a vertical member.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents disclose the state of the art with respect to suspended applicator instruments: Truitt (US 4,077,111) and Richardson (US 3,021,227).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura E. Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura E. Edwards  
Primary Examiner  
Art Unit 1734

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September 3, 2002